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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/745,927

Filing Date: December 21, 2000

Appellant(s): SNOWDON ET AL.

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**Jeannette M. Walder**  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/22/06 appealing from the Office action  
mailed 7/17/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,585,154	Ostrover et al.	7-2003
6,533,171	Porter	3-2003
5,456,307	Klotz, Jr.	10-1995
6,477,243	Choksi et al.	11-2002
5,417,508	Friedman	5-1995

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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1. Claims 1, 3, 5, 10, 11, 13, 15-17, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover (US 6585154) in view of Porter (US 6533171).

Regarding claim 1, Ostrover discloses a programmable document comprising a physical document including at least one sheet of material and information recorded thereon (see column 4 lines 27-29 and 43-45), and a computer attached to the physical document, wherein the computer includes an input/output device, a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information (see column 4 line 43-column 5 line 21, reference states that the data may be in a standard file format in which the examples listed inherently have metadata, such as TIFF files, and also states that the microchip may contain an indicator that indicates when the data has been altered), a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, and column 5 lines 1 and 15-20), and a computer program, stored in the memory, for implementing defined actions, operable by the processor, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available (see column 4 lines 44-65, column 5 lines 9-21, and column 6 lines 15-41).

Ostrover does not disclose expressly that the processor and the computer program are located within the microchip. Rather the processor and the computer program are located with the external computing device, i.e. a computer, printer, or copier.

Porter discloses an iButton that is capable of storing business card information as well as an individuals interests, curriculum vitae, a photograph, or other useful information (see column 5 lines 1-7).

Regarding claim 10, Ostrover discloses a method for managing, retrieving and processing information about a physical document and modifications to the physical document, comprising: providing a computer, wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document, and a memory (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, column 5 lines 1-21, and column 6 lines 53-60) recording information on at least one sheet of material to generate a physical document (see column 5 lines 16-22 and 66-67 and column 6 lines 1-3), storing a digital copy of the recorded information, any updates and modifications to the recorded information, and all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information in the memory (see column 4 line 43-column 5 line 21, reference states that the data may be in a standard file format in which the examples listed inherently have metadata), storing a computer program in the memory, for implementing defined actions, operable by the

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processor (see column 4 lines 44-65, column 5 lines 9-21, and column 6 lines 15-41) associating the stored recorded information and metadata with the physical document (see column 6 lines 16-22), and attaching the computer to the physical document, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available (see column 4 line 44-column 5 line 21).

Ostrover does not disclose expressly that the processor and the computer program are located within the microchip. Rather the processor and the computer program are located with the external computing device, i.e. a computer, printer, or copier.

Porter discloses an iButton that is capable of storing business card information as well as an individuals interests, curriculum vitae, a photograph, or other useful information (see column 5 lines 1-7).

Ostrover & Porter are combinable because they are from electronic data copies of physically printed documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the microchip of Ostrover with the iButton of Porter. The iButton and it's associated capabilities are well known in the art and therefore it would have been obvious to execute the processes, disclosed by Ostrover as being performed by the computing device, by the iButton.

The suggestion/motivation for doing so would have been to provide a low-cost low-effort solution to storing information.

Therefore, it would have been obvious to combine Porter with Ostrover to obtain the invention as specified in claims 1 and 10.

Regarding claim 3, Ostrover and Porter disclose the system discussed in claim 1, and Ostrover further discloses wherein the computer is attached to the physical document by at least one of an adhesive, a removable adhesive, a magnetic material (see column 5 lines 2-9).

Regarding claims 5 and 19, Ostrover and Porter disclose the system discussed in claim 1, and Porter further discloses a similar system that makes use of an iButton (see column 2 lines 21-25, column 4 lines 35-48, and column 5 lines 1-7).

Regarding claim 11, Ostrover and Porter disclose the system discussed in claim 10, and Ostrover further discloses performing an activity pertaining to the physical document and storing a digital record of the performed activity in the computer (see columns 4-6, reference teaches that information is recorded on a physical document, i.e. paper, and digital data is stored on a microchip that is an electronic copy of the information recorded on the physical document).

Regarding claim 13, Ostrover and Porter disclose the system discussed in claim 10, and Ostrover further discloses wherein the computer is attached to the physical document by an adhesive (see column 5 lines 2-9).

Regarding claim 15, Ostrover and Porter disclose the system discussed in claim 11, and Ostrover further discloses wherein the activity is selected from the group consisting of copying, providing comments, scanning, referencing an earlier version of

the information (see columns 5 and 6, reference teaches a device which reads/writes to the microchip can be one of a printer, photocopy machine or a scanner, a photocopy or printer can be used to record information on the physical document and the digital representation of which is stored in the microchip).

Regarding claim 16, Ostrover and Porter disclose the system discussed in claim 1, and Ostrover further discloses wherein the metadata comprises at least one of an electronic copy of the information recorded on the physical document, comments by readers of the document, state changes and edits made since the document was printed, processing information, version information, copy information, transformation information, distribution information, index information, and other miscellaneous information (see column 3 lines 60-67 and column 4 lines 1-10 and 43-64).

Regarding claim 17, Ostrover and Porter disclose the system discussed in claim 1, and Ostrover further discloses wherein the miscellaneous information comprises at least one of a document summary and key words (see column 6 lines 16-19, reference shows at least a portion of the content of the electronic copy of the physical document is stored in the memory device of the microchip which is equivalent to a document summary).

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover and Porter as applied to claim 1 above, and further in view of Klotz, Jr. (US 5459307).

Ostrover and Porter do not disclose expressly wherein the computer has a machine-readable label.

Klotz discloses a machine-readable label (see column 3 lines 54-66 and column 5 lines 1-7 and 20-33, reference teaches a machine readable file storage sheet flag which informs the system that a machine readable sheet containing digitally encoded files is going to be read).

Ostrover, Porter, & Klotz are combinable because they are from a similar problem solving area, notifying system about current document by way of a machine-readable label.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the machine-readable label of Klotz with the system of Ostrover and Porter.

The suggestion/motivation for doing so would have been to provide the ability to notify the system about the current document that is about to be read. Klotz teaches the significance of the label is to inform the system that a file storage sheet follows and in turn the system knows where to scan the page for file attribute information. By implementing this advantage into the current invention allows a "modified" (as stated by applicants) printer, photocopier, or fax machine to know when the system is going to process a document that has an attached computer and enable read/write capabilities.

Therefore, it would have been obvious to combine Klotz with Ostrover and Porter to obtain the invention as specified in claim 6.

3. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover and Porter as applied to claim 1 above, and further in view of Choksi (US 6477243).

Ostrover and Porter do not disclose expressly storing a URL for a digital version of the information recorded on the physical document.

Choksi discloses storing a URL for a digital version of the information recorded on the physical document (see column 3 lines 55-64, column 8 lines 49-67, and Fig. 5, reference teaches a system in which upon receiving a facsimile message a confirmation message is sent to the user notifying the user of the facsimile message and the URL where the message is located).

Ostrover, Porter, & Choksi are combinable because they are from the same field of endeavor, electronic storage of a physical document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the larger storage space provided by a URL of Choksi with the idea of storing an electronic copy of a physical document of Ostrover and Porter.

The suggestion/motivation for doing so would have been storing electronic data corresponding to a physical document by using a URL because of the larger amount of storage space available on a network environment. Choksi points out the benefits of being able to transmit larger files by way of a message containing a URL which points to the location of a document rather than sending the file as an attachment in a e-mail message and risking the file exceeding a certain size limit and thus being stripped off the e-mail or being unable to send the attachment (see column 1).

Therefore, it would have been obvious to combine Choksi with Ostrover and Porter to obtain the invention as specified in claim 18.

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4. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover and Porter as applied to claims 1 and 10 above, and further in view of Friedman (US 5417508).

Ostrover and Porter do not disclose expressly wherein the computer is attached to the physical document by a spiral binding.

Friedman discloses attaching physical documents with a spiral binding (see Figs. 1-5, column 2 lines 58-67, and column 3 lines 1-45).

Ostrover, Porter, & Friedman are combinable because they are from a similar problem solving area, attachment of multiple documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the attachment of documents using a spiral binding of Friedman with system of Ostrover and Porter.

The suggestion/motivation for doing so would have been to physically attach the microchip to the physical document.

Therefore, it would have been obvious to combine Friedman with Ostrover and Porter to obtain the invention as specified in claims 4 and 14.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover.

Ostrover fails to explicitly disclose wherein the metadata comprises text, or portions thereof, of the information recorded on the document which has been translated into another language. However, Ostrover does state that the digital data

can be in a number of different formats or languages and it is known in the art that metadata is data about data and refers to things such as origin, size, and formatting, and it is also known in the art that files or documents are changed to different formats on a regular basis for a multitude of reasons. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention that metadata stores text, or a portion thereof, of the information recorded on the document which has been translated into another language.

#### **(10) Response to Argument**

Applicant's arguments filed 12/22/06 have been fully considered but they are not persuasive.

Regarding claims 1, 3, 5, 10, 11, 13, 15-17, and 19, the applicant states, on pages 8-9 of the Appeal Brief, Ostrover (US 6,585,154) teaches different content can be stored in the microchip in different file formats, but asserts while some document file formats may include metadata, the mere fact of metadata within a file format does not teach or suggest a programmable document which includes, in part, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information. The examiner respectfully disagrees as Ostrover does disclose such a feature. Particularly, Ostrover discloses a processor for updating and modifying the recorded information in

digital form located within an external computing device, which may be located in a printer or copier. Ostrover also discloses that the electronic copy of the document is stored in the microchip in a "standard file format", such as Tagged Image File Format (TIFF), Windows Enhanced Meta File, and Windows Meta File, among a number of other listed formats (see column 4 lines 47-65). It is well known in the art that TIFF files contain metadata. It is an inherent feature of TIFF files, as well as many other file formats, to contain metadata. Further, most programs that create documents, including Microsoft Word, save metadata pertaining to the document. The metadata can contain the name of the person who created the file, the name of the person who last edited the file, how many times the file has been printed (copy or distribution information), and even how many revisions have been made to the file (version information). Ostrover discloses that an electronic copy of a physical document is stored in a microchip in a "standard file format", such as a TIFF, and since the TIFF file contains metadata, the metadata is thus also stored in the microchip. Therefore, Ostrover anticipates the limitation of storing metadata pertaining to the physical document, as set forth above, because Ostrover discloses storing an electronic copy of a physical document in a microchip in a file format such as TIFF, which inherently contains metadata.

Applicant also asserts, on pages 10-11 of the Appeal Brief, the combination of Ostrover (us 6,585,154) and Porter (US 6,533,171) does not teach the appellant's invention and that Porter teaches away from the use of paper. The examiner respectfully disagrees as Ostrover and Porter do disclose the appellant's invention and if one of ordinary skill in the art was presented with the teachings of Ostrover and the

teachings of Porter, at the time the invention was made, it would have been obvious to combine the teachings as to arrive at the appellant's invention. Porter discloses a particular use for an iButton (see column 2 lines 22-26). The iButton can be used to store information, such as photographs and textual information, which later can be retrieved and used as desired (see column 5 lines 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the microchip of Ostrover with the iButton described by Porter. The iButton contains a memory and a processor capable of updating and modifying information. The reference of Porter was used to show that iButtons are well known in the art and are used to store information relating to physical information, which is the same reason for the use of the microchip of Ostrover. Therefore Ostrover and Porter are combinable because they both deal with storing digital information in a "microchip" type device.

Regarding claims 4, 6, 14, 18, and 20, the applicant states, on pages 11-12 of the Appeal Brief, that since these claims depend from independent claims 1 or 10 they are believed to be patentable, since claims 1 and 10 are believed to be patentable because they are not taught or suggested by Ostrover or Porter, as set forth on pages 8-9 of the Appeal Brief. The examiner disagrees for the same reasons as set forth above regarding claims 1, 3, 5, 10, 11, 13, 15-17, and 19.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark R. Milia

4/27/07

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